

Remarks

By this Amendment, one paragraph in the specification is amended to overcome an objection, as discussed below. In addition, claims 43, 45, 47, and 59 are amended, as discussed below. No new matter has been added by these amendments. After entry of this amendment, **claims 43-45, 47, 51, and 59 are pending** in the application.

Telephone Interview

Applicants thank the Examiner for the courtesy of a telephone interview on February 17, 2004. Present at that interview were Examiner Susan Ungar and Applicants' undersigned representative, Tanya Harding. Informal proposed claim amendments, submitted by facsimile to the Examiner on February 12, 2004, were discussed. These proposed amendments addressed the rejections under 35 U.S.C. §103, as well as correcting spelling conventions in claims 43 and 45. Proposed amended claims 43 and 45 were accepted by the Examiner, and considered allowable, as were claims 44 and 51 without further amendment. The Examiner suggested further amendments to claims 47 and 59, to ensure that the language of these claims reflected the amended language in claim 43. It is believed that agreement was reached with the Examiner, regarding the allowability of the claims submitted herewith.

Applicants' representative also discussed with the Examiner the objection to the Amendment of the specification, regarding alleged introduction of new matter by the incorporation by reference in the Paper submitted on January 22, 2001. Applicants' representative agreed to cancel the incorporation by reference of U.S. Patent No. 6,040,169, since incorporation of this document is not essential to the application. The Examiner agreed that the discussed cancellation would overcome this rejection.

Rejections under 35 U.S.C. §103

All of the claims pending in the application stand rejected under 35 U.S.C. §103, for reasons previously set forth in Paper No. 34, Section 4, pages 1-2; and Paper No. 31, Section 7, pages 4-6. Applicants traverse these rejections of the claims, at least for the grounds previously submitted. In addition, Applicants submit herewith amendments to claims 43 and 59, as

discussed with and agreed upon by the Examiner during the January 17 telephone interview, which amendments are believed to clarify Applicants' invention in view of these rejections. The amended claims are not obvious in light of the cited references, and withdrawal of this rejection is therefore requested.

In particular, claims 43 and 59 are amended to provide closed language, which precludes a non-functional ribonucleotide reductase gene required by the prior art. The Examiner has considered this amended claim language, and agreed during the January 17 telephone interview that it overcomes these rejections.

The use of an HSV-1 mutant that is mutated only in the γ 34.5 is amply described in the specification, including: description of HSV1716 (which is only mutated in this gene) and its use, for instance at page 4, lines 1-2, and in Example 1 (comparing the "relative abilities" of HSV-1 wild-type and various mutant, *i.e.*, modified, viruses, including HSV1716) (see Table 1). Even though mutations in other genes are mentioned, it is clear that these are alternative embodiments, rather than features required by the invention. See page 5, lines 14-19 (discussing mutation of γ 34.5) in comparison to page 6, lines 15-19 (stating that "it **may** be advantageous" to include other mutations, but it is not essential) (emphasis added).

Regarding the Randozzo *et al.* article (*Virology* 211, 94-101, 1995) which was apparently omitted from the prior submission, Applicants provide a copy of the article with the Information Disclosure Statement filed herewith.

Objection to the Amendment of the Specification

The objection to incorporation by reference of U.S. Patent No. 6,040,169 at page 4 of the specification, as entered into the case in the Paper filed on January 21, 2001, has been maintained on the ground that it allegedly introduces new matter into the specification.

While Applicants traverse this objection at least on the grounds previously submitted to the Patent Office, in order to advance the prosecution of the application, the phrase "the entire contents of which is incorporated herein by reference" is cancelled from the specification by the

amendment submitted herewith. It is believed that this amendment overcomes the objection, and Applicants request that the objection be withdrawn.

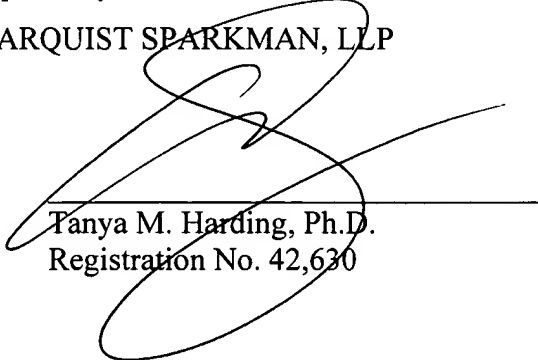
Applicants remind the Examiner that the virus strain 1716 has been deposited in a Budapest Treaty depository, and that this fact has been entered into the specification in the Paper filed on January 22, 2001. A copy of the Certification of the deposit was also provided with that Paper. In addition, a Declaration of Deposited Materials (including a duplicate copy of the Certification of the deposit for virus mutant 1716) was provided with the Request for Continued Examination (RCE), submitted on April 5, 2002.

Conclusions

It is believed that this case is in condition for allowance, and such action is requested. If anything further is required, or if the Examiner believes that a telephone conference would expedite consideration of this case, she is encouraged to telephone the undersigned.

Respectfully submitted,
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